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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,077	10/17/2001	Kevin Ronald Franklin	J3568(C)	7270
201	7590	07/12/2004	EXAMINER	
UNILEVER PATENT DEPARTMENT 45 RIVER ROAD EDGEWATER, NJ 07020			WHITE, EVERETT NMN	
			ART UNIT	PAPER NUMBER
			1623	

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/982,077	<b>Applicant(s)</b> FRANKLIN ET AL.	
	<b>Examiner</b> EVERETT WHITE	<b>Art Unit</b> 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,11-50 and 52-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,11-23,28-50 and 52-55 is/are rejected.
- 7) ☒ Claim(s) 24-27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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### DETAILED ACTION

1. The amendment filed April 29, 2004 has been received, entered and carefully considered. The amendment affects the instant application accordingly:
  - (A) Claims 2 and 10 have been cancelled; Claim 51 was previously canceled.
  - (B) New Claims 52-55 have been added.
  - (C) Claims 1, 6, 13-15 and 24 have been amended.
  - (D) Comments regarding Office Action have been provided drawn to:
    - (a) 101 statutory double patenting rejection, which has been withdrawn;
    - (b) Non-statutory double patenting rejection, which has been maintained;
    - (c) Objection to the title, which has been withdrawn.
2. Claims 1, 3-9, 11-50 and 52-55 are pending in the case.
3. The text of those sections of Title 35, U. S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

4. Claims **1, 3-9, 11-50 and 52-55** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In **Claim 1** what is the purpose of separating 6 locations of the R-CO- group to represent X from a R-CO- group at the seventh location? This language appears to be unnecessary unless the R-CO- group at the seventh location is somehow different from the R-CO- group at the other 6 locations, which has not been set forth in the claims. This language in Claim 1 renders Claim 1 and claims dependent from Claim 1 (see **Claims 3-9, 11-50 and 52-55**) indefinite.

In **Claim 1**, what does "R-2" and "R+2" mean? It appears that the claim intended for "R-2" and "R+2" to denote a numerical value for an amount of carbons representing R'. This would be improper and confusing since R is disclosed in the claim to represent hydrocarbon residues and not a numerical value. This language in Claim 1 renders Claim 1 and claims dependent from Claim 1 (see **Claims 3-9, 11-50 and 52-55**) indefinite.

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In **Claim 24**, line 4, should a comma be located after "H"? The presence of the comma at this location makes the newly added passage following the comma unclear. The passage appears to lack proper idiomatic language or proper punctuation, which renders Claim 24 and Claims dependent from Claim 24 (see **Claims 25 and 26**) indefinite.

### ***Double Patenting - Nonstatutory***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 3-9, 11-23, 28-50 and 52-55 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-5, 9-15 and 18-22 of U.S. Patent No. 6,458,344. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason.

Applicants claim an acylated cellobiose and compositions thereof wherein the acylated cellobiose satisfies the formula set forth in instant Claim 1 in which X represents an acyl group R-CO- or H, Z represents an acyl group R'-CO- or H and not more than a minority of R + R' residues represent H and in the remaining R + R' residues, R represents a saturated or unsaturated, linear or branched chain hydrocarbon residue containing from 5 to 31 carbon atoms and R' represents a residue which is different from R and which is: (i) a saturated or unsaturated, linear or branched

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chain hydrocarbon residue containing from 1 to 31 carbon atoms optionally substituted or (ii) an aromatic hydrocarbon residue, optionally substituted or (iii) a cycloaliphatic hydrocarbon, optionally substituted. Additional limitations in the dependent claims include specific R and R' groups and major fractions of the acylated cellobiose being the  $\alpha$ -anomer or the  $\beta$ -anomer.

U.S. Patent No. 6,458,344 (Franklin et al patent) sets forth claims directed to a partially esterified cellobiose containing at least two glucose residues joined in  $\beta$ -1,4-configuration having the formula set forth in Claim 18 thereof, wherein each Z is independently hydrogen or an acyl group of the formula RCO- where R denotes a hydrocarbyl group containing from 7-11 carbon atoms, with the proviso that not more than half of the Z groups are hydrogen at least 80% of esterified cellobiose is fully esterified and (b) at least 80% of the esterified cellobiose is present as the  $\alpha$ -anomer. The instant claims differ from the claims of the Franklin et al patent by claiming that the R' residue represents a residue which is different from R. That is, the Z symbol when represented as an acyl group located at the anomer position in the esterified cellobiose in the claims of the Franklin et al patent, which is different from the other acyl groups located at the Z symbols in the esterified cellobiose, is not specifically recited in the Franklin et al patent. However, Claim 1 of the Franklin et al patent does set forth that each of the Z symbols are independently selected which may result in the Z symbol located at the anomer position of the esterified cellobiose being different from the acyl groups located at the other Z symbol locations. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of Applicants invention having the Franklin et al patent before him to replace the Z symbol at the anomer position with an acyl group that is different from the acyl groups located at the other Z symbol positions, in view of the independent selectivity of each Z group and the resulting expectation of the esterified cellobioses having similar cosmetic properties.

7. Applicant's arguments with respect to Claims 1, 3-9, 11-23, 28-50 and 52-55 have been considered but are moot in view of the new ground(s) of rejection.

***Claims Objected To***

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8. Claims 24-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Summary***

9. Claims 1, 3-9, 11-23, 28-50 and 52-55 are rejected; Claims 24-27 are objected to.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Examiner's Telephone Number, Fax Number, and Other Information***

11. For 24 hour access to patent application information 7 days per week, or for filing applications, please visit our website at [www.uspto.gov](http://www.uspto.gov) and click on the button "Patent Electronic Business Center" for more information.

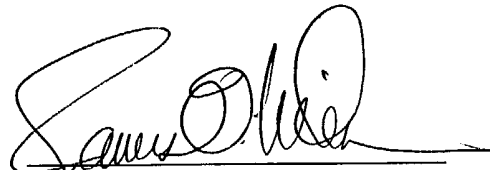
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is (571) 272-0660. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached on (571) 272-0661. The fax phone number for this Group is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

  
E. White

  
James O. Wilson  
Supervisory Primary Examiner  
**Technology Center 1600**